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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,674	10/14/2003	Lynn A. Buckner		1817

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EXAMINER	
SCHNEIDER, CRAIG M	
ART UNIT	**PAPER NUMBER**
3753	
MAIL DATE	**DELIVERY MODE**
10/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/683,674	BUCKNER ET AL.	
	Examiner	Art Unit	
	CRAIG M. SCHNEIDER	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2008*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-43* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *33-43* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *28 August 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/28/08 has been entered.

Drawings

2. The drawings were received on 6/27/08. These drawings are acceptable.

Specification

3. The specification amendments submitted on 6/27/08 overcome the objections of the final office action dated 2/28/08 and are accepted.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 33, 34, 38, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz (6,013,138) in view of Jackman (4,561,459).

Sinz discloses a mobile utility valve exerciser means comprising the steps of: providing a vacuum container (13), the vacuum container having a vacuum producing means (21) to create a vacuum within the vacuum container, and further comprising the step of providing a conduit (19) to vacuum solid particles into the vacuum container

(1)(col. 8, lines 45-67). Sinz does not disclose the step of the utility valve exerciser means being chosen from a group consisting from a hydraulic motor, a D.C. motor, an A.C. motor, an air motor or a cylinder, and further comprising the step of the utility valve exerciser means having a rotating shaft, and the rotating shaft further comprising the step of having a means of attaching to the valve stem of the utility valve and further comprising the step of opening or closing a utility valve by rotating the valve stem of the utility valve and the utility valve exerciser means being mounted adjacent to an articulate boom arm having two or more articulated arms; and the utility valve exerciser and the articulate boom arm being mounted on the mobile platform. Jackman discloses the use of a utility valve exerciser (40) using a DC motor having a rotating shaft (44) and the exerciser being mounted on an articulate boom arm having two or more arms (33 and 34) that is inherently on a mobile platform (col. 3, lines 41-48 and col. 4, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the actuator of Jackman onto the device of Sinz, in order to be able to operate the valve remotely.

Regarding claim 34, all the limitations of the claim are similar to the limitations of claim 33 except the following which is evident per Sinz. The method further comprising the step of mounting a liquid pressure dissipater means (14) adjacent to the vacuum excavation means and wherein the liquid pressure dissipater further comprises the steps of having an inlet (79) to accept water under pressure from a water fire hydrant, an internal water deflector (the tank with the raised pipe 73 to prevent drainage until the correct water level is reached) to absorb energy in the form of pressure, and an outlet (88) to allow water to exit the liquid pressure dissipater.

Regarding claim 38, Jackman further discloses mounting a control adjacent to the utility valve exerciser and the controller (27) further comprising the step of reversing the rotation of the rotate able shaft.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further include the controls of the utility valve exerciser of Jackman onto the device of Sinz, in order to have local control of the exerciser.

Regarding claim 42, Sinz discloses an additional step of mounting a water tank (15), water pump (20), water hose (16) and water spray nozzle (17) adjacent to the mobile platform, and further comprising the step of using the water spray nozzle to make vacuum able the earthen material found in the ground casing to the utility valve stem (col. 4, lines 32-34 and 41-61).

6. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman in combination as applied to claim 33 above, and further in view of Reuschel et al. (6,776,068).

Sinz/Jackman disclose all the features of the claimed invention except that wherein the mobile utility valve exerciser and vacuum excavation method comprises an additional step of the rotate able shaft having an extension adapter for connecting the utility valve exerciser rotate able shaft to the valve stem of a utility valve. Reuschel et al. disclose the use of an extension (20) adapter for connecting the utility valve exerciser rotate able shaft (22) to the valve stem of a utility valve (16)(col. 3, lines 49-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the extension rod of Reuschel et al. with the device of Sinz/Jackman, in order to access valves that are not readily available.

7. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman in combination as applied to claim 33 or 34 above, and further in view of Reischl et al. (6,679,222).

Sinz/Jackman disclose all the features of the claimed invention except that wherein the mobile utility valve exerciser and vacuum excavation method comprises an additional step of mounting a sensor adjacent the utility valve exerciser to measure the torque required to rotate the rotate able shaft of the utility valve exerciser. Reischl et al. disclose measuring the torque of a shaft (col. 4, lines 50-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the torque sensor of Reischl et al. onto the shaft of the utility valve exerciser of Sinz/Jackman, in order to measure the torque.

8. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman in combination as applied to claim 33 or 34 above, and further in view of Ward (4,085,551).

Sinz/Jackman disclose all the features of the claimed invention except that wherein the mobile utility valve exerciser and vacuum excavation method comprises an additional step of mounting a sensor adjacent the utility valve exerciser to count the revolutions of the rotate able shaft of the utility valve exerciser. Ward discloses measuring the number of revolutions (col. 2, lines 13-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the number of revolutions measuring device of Ward onto the shaft of the utility valve exerciser of Sinz/Jackman, in order to measure the number of revolutions.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman as applied to claim 33 or 34 above, and further in view of Smith et al. (6,850,843).

Sinz/Jackman disclose all the features of the claimed invention except that wherein the mobile utility valve exerciser and vacuum excavation method comprises an additional step of: mounting a sensor adjacent to the utility valve exerciser to locate the global location of the utility valve exerciser. Smith et al. disclose the use of a Global Positioning System to determine the geographic location of an accident and all the corresponding data using a computer and a portable sensor (3)(col. 4, lines 56-67 onto col. 5, lines 1-60).

It would have been obvious to one having ordinary skill in the art to include a GPS system as described by Smith et al. onto the device of Sinz/Jackman, in order to have an accurate location of the device.

10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman in combination as applied to claims 33 or 34 above, and further in view of Reischl et al. (6,679,222) and Ward (4,085,551).

Sinz/Jackman disclose all the features of the claimed invention except mounting two or more sensors adjacent to the utility valve exerciser and the sensors further comprising the step of transmitting sensor collected information to a computer. Reischl et al. disclose measuring the torque of a shaft (col. 4, lines 50-53) and Ward discloses measuring the number of revolutions (col. 2, lines 13-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the torque sensor of Reischl et al. and the number of rotation sensor of Ward onto the device of Sinz/Jackman, in order to measure the torque and the number of rotations.

11. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinz/Jackman in combination as applied to claims 33 or 34 above, and further in view of Hilbig (3,678,534).

Sinz/Jackman discloses an additional step of mounting an air tank (14) and air compressor (21). Sinz does not disclose an air hose and air nozzle mounted adjacent to the mobile platform and further comprising the step of using the air nozzle to make vacuum able the earthen material found in the ground casing to the utility valve stem. Hilbig discloses an air hose (12) with a vacuum conduit (11) to make the debris vacuum able (col. 1, lines 31-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the air hose and vacuum arrangement as disclosed by Hilbig as an alternative to the water hose/vacuum hose set up of Sinz/Jackman, in order to eliminate the need for filtering all the water.

Response to Arguments

12. Applicant's arguments filed 8/28/08 have been fully considered but they are not persuasive. The argument that Sinz is of non-analogous art is unpersuasive. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, The patent to Sinz is clearly within the field of applicants' endeavor, that being a mobile vacuum facility to clean out access pipes to buried valves. Clearly the patent to Sinz is directed to a mobile vacuum facility. The use, e.g. to clean out valve access pipes can clearly be performed by the device of Sinz. Even so, the device of Sinz is clearly related to the particular problem with which applicant is concerned, that being the problem of cleaning out otherwise debris filled pipes. Clearly a mobile vacuum facility such as disclosed by Sinz is of particular relevance to applicants disclosed solution, that being a mobile vacuum facility.

13. The general argument that Jackson does not teach or suggest vacuum excavations is, although correct, not relevant to the question of obviousness. Generally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The allegation that the proposed combination of Sinz and Jackson does not meet the claimed limitations is nothing more than an allegation absent any specific reasons as to claimed structure not found in the reference(s).

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the patent to Jackson is relied on for its teaching of a utility valve exerciser (40) using a DC motor having a rotating shaft (44) and the exerciser being mounted on an articulate boom arm having two or more arms (33 and 34) that is inherently on a mobile platform as set forth in col. 3, lines 41-48 and col. 4, lines 1-6.

15. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the in ground utility valve) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant is indicating that the Jackman device can not open and close a utility valve that is in the ground. While this is not part of the claim language the examiner disagrees with applicant's argument. The device of Jackman is capable of

performing the opening and closing of an in-ground utility valve which is further indicated by the combination of Reuschel et al. with Sinz and Jackman. Jackman has all the structure that is needed to perform the intended use.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRAIG M. SCHNEIDER whose telephone number is (571)272-3607. The examiner can normally be reached on M-F 8:00 -4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. M. S./
Examiner, Art Unit 3753
October 9, 2008

/John Rivell/
Primary Examiner, Art Unit 3753